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In re Application of :
Pedeli :
US Application No.: 09/806,526 :
PCT Application No.: PCT/AU99/00845 :
International Filing Date: 1 October 1999 :
Priority Date: 1 October 1998 :
Attorney's Docket No.: A-70470/MAK :
For: METHOD FOR TREATMENT OF :
VULCANIZED RUBBER :

DECISION ON PETITION
UNDER 37 CFR 1.47(b)

This decision concerns the "Further Request for Reconsideration, and (Alternatively) Petition to Suspend the Rules (MPEP 2001)" filed on 25 November 2002. For reasons stated below, this renewed request for status under 37 CFR 1.42 is being treated as a petition under 37 CFR 1.47(b), and is **DISMISSED**.

BACKGROUND

The sole inventor named in this application died in 1993. On 1 October 1999, the executrix of the decedent's estate who is also his widow filed international application PCT/AU99/00845, which claimed priority of an earlier application filed on 1 October 1998. A copy of the international application was communicated from the International Bureau to the USPTO on 13 April 2000. A Demand for International Preliminary Examination was filed on 1 May 2000, the end of the 19th month from the 1 October 1998 priority date. The period for paying the basic national fee is thus 30 months and ended at midnight on 1 April 2001.

On 30 March 2001, a transmittal letter for entry into the national stage in the United States (Form PTO-1390) was filed along with, *inter alia*, the \$500 (small entity) basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(3), but not an oath or declaration.

On 22 May 2001, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed, stating that an oath or declaration as required by 35 U.S.C. 371(c)(4) was missing, and requesting submission of an oath or declaration within 2 months of mailing of the Notification of Missing Requirements (i.e., 22 July 2001), or, 32 months of the priority date (i.e., 1 June 2001). The reply period was extendable under 37 CFR 1.136(a).

On 22 January 2002 (Certificate of Mailing date 20 December 2001), a declaration signed by the executrix/widow of the deceased inventor was filed along with a 5-month extension of time

and the extension-of-time fee. That declaration was not accepted, in that, it did not include the executrix/widow's own citizenship, mailing address and residence. 37 CFR 1.497(b)(2); MPEP 605.04(a) (Rev.1 , Feb. 2003).

On 10 May 2002, a "Request for Reconsideration of Decision" was filed but did not include a proper oath or declaration signed by the deceased inventor's executrix/widow, and was dismissed on 18 September 2002.

The instant petition asserts that the deceased inventor's executrix/widow refuses to execute another declaration, and requests acceptance of the previously rejected declaration, in essence suggesting that the information concerning the executrix/widow's citizenship, mailing address and residence be extracted from the PCT Request.

DISCUSSION

The 37 CFR 1.42 REQUEST AS FILED IS NOT GRANTABLE

When an inventor for the claimed invention in a patent application is deceased, the legal representative (executor, administrator, etc.) or one who has reason to believe that he/she will be appointed legal representative may make the necessary oath or declaration. 35 U.S.C. 117; 37 CFR 1.42; MPEP 409.01(a) (Rev. 1, Feb. 2003). In so making the oath or declaration on behalf of the deceased inventor, the legal representative must, in the oath or declaration: (1) identify himself/herself as the legal representative of the deceased inventor; 37 CFR 1.497(b)(2); MPEP 605.04(a) (Rev.1 , Feb. 2003); (2) provide his/her own citizenship, mailing address and residence; *Id.*; and (3) include the citizenship of the deceased inventor. 37 CFR 1.497(a)(3).

The U.S. patent statute also requires that an oath state the citizenship of each of the inventors. 35 U.S.C. 115. Clearly, the filing of a declaration in lieu of an oath does not result in removal of that requirement which is statutory and cannot be waived. Moreover, a legal representative making the oath or declaration for a deceased inventor is subject to the same terms and conditions applicable to the inventor. 35 U.S.C. 117.

As the Office stated in the previous decisions, the declaration filed on 22 January 2002 meets requirements (1) and (3), but not (2). While the mailing address and the residence of the deceased inventor's executrix/widow may be provided in an application data sheet, her citizenship may not. The declaration submitted on 22 January 2002 does not state the citizenship of the deceased inventor's executrix/widow who is making the declaration for the deceased inventor, and is unacceptable.

§1.42 REQUEST TREATED AS §1.47(b) PETITION

The instant request indicates that the deceased inventor's entire interest in the claimed invention was assigned to Joseph Montalto.

In the instant case, the deceased sole inventor's executrix/widow refuses to sign the application declaration. Under 37 CFR 1.47(b), Joseph Montalto, as the assignee of the entire interest in the patent application, may make the application oath or declaration on behalf of, and as agent for, the non-signing executrix/widow. MPEP 409.03© (Rev. 1, Feb. 2003).

The oath or declaration must be accompanied by a petition that includes:

- (1) proof that:
 - (A) the deceased inventor assigned the claimed invention to Joseph Montalto; and a statement under 37 CFR 3.73(b) signed by Joseph Montalto, establishing Joseph Montalto's ownership in the claimed invention to enable him to prosecute this application before the USPTO; or,
 - (B) the deceased inventor agreed in writing to assign the claimed invention to Joseph Montalto; or,
 - (C) Joseph Montalto otherwise has sufficient proprietary interest in the claimed invention to justify the filing of this application.37 CFR 1.47(b); MPEP 409.03(f) (Rev. 1, Feb. 2003);
- (2) a showing that Joseph Montalto or his representative made a *bona fide* attempt, in vain, to obtain the signature of the deceased inventor's executrix/widow on the oath or declaration; 37 CFR 1.47(b); MPEP 409.03(d) (Rev. 1, Feb. 2003)
REFUSAL TO JOIN;
- (3) a showing (statement) that filing the application by Joseph Montalto on behalf of, and as agent for, the non-signing executrix/widow of the deceased inventor is necessary to preserve the rights of the parties or to prevent irreparable damage; 37 CFR 1.47(b); MPEP 409.03(g) (Rev. 1, Feb. 2003);
- (4) an application oath or declaration signed by Joseph Montalto on behalf of, and as agent for, the deceased inventor's executrix/widow;
- (5) the petition fee set forth in 37 CFR 1.17(h), currently \$130; 37 CFR 1.47(b); and
- (6) the last known address of the non-signing executrix/widow of the deceased inventor; 37 CFR 1.47(b). MPEP 409.03(e) (Rev. 1, Feb. 2003).

The instant §1.47(b) petition lacks items (1), (3), (4) and (5).

CONCLUSION

In view of the above, the instant §1.42 Request, while treated as a §1.47(b) petition, is also **DISMISSED**.


A renewed §1.47(b) petition must be filed **WITHIN TWO MONTHS** of the mailing date of this decision, and be accompanied by the items discussed above, as appropriate, if not previously submitted. The 2-month period is extendable under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to:

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